



INTERNATIONAL TRADE COMMISSION

[Investigation No. 337-TA-1067 (Remand)]

Certain Road Milling Machines and Components Thereof; Issuance of a Modified Limited Exclusion Order and Two Modified Cease and Desist Orders; Termination of Remand Investigation

AGENCY: International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that, following a remand from the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”), the U.S. International Trade Commission has determined to issue a modified limited exclusion order (“LEO”) and modified cease and desist orders (“CDOs”) directed against respondents Caterpillar Paving Products, Inc. and Caterpillar Inc., respectively, and their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns. The Commission has terminated this investigation.

FOR FURTHER INFORMATION CONTACT: Michael Liberman, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-3115. Copies of non-confidential documents filed in connection with this investigation may be viewed on the Commission’s electronic docket (EDIS) at <https://edis.usitc.gov>. For help accessing EDIS, please email EDIS3Help@usitc.gov. General information concerning the Commission may also be obtained by accessing its Internet server at <http://www.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on August 25, 2017, based on a complaint filed by Wirtgen America, Inc. of Antioch, Tennessee (“Wirtgen” or “Complainant”). 82 FR 40595-96 (Aug. 25, 2017). The complaint alleges a violation of section 337 by reason of infringement of certain claims of U.S. Patent Nos. 7,530,641 (“the ’641 patent”); 7,828,309 (“the ’309 patent”); 9,624,628 (“the ’628 patent”); 9,644,340 (“the ’340 patent”); and

9,656,530 (“the ’530 patent”). The notice of investigation named as respondents Caterpillar Prodotti Stradali S.r.L. of Minerbio BO, Italy; Caterpillar Americas CV of Geneva, Switzerland; Caterpillar Paving Products, Inc. of Minneapolis, Minnesota; and Caterpillar Inc., of Peoria, Illinois (collectively, “Caterpillar,” or “Respondents”) and Caterpillar Bitelli SpA of Minerbio BO, Italy. The Commission’s Office of Unfair Import Investigations was named as a party, but later withdrew from the investigation. Commission Investigative Staff’s Notice of Non-Participation (Oct. 31, 2017)

On April 27, 2018, the Commission terminated the investigation as to the ’628 patent based on withdrawal of the complaint allegations as to that patent. *See* Order No. 30 (Mar. 27, 2018), *unreviewed by* Notice (Apr. 27, 2018). On January 18, 2018, the Commission terminated respondent Caterpillar Bitelli SpA based on the withdrawal of the complaint as to that respondent. *See* Order No. 11 (Dec. 19, 2017), *unreviewed by* Notice (Jan. 18, 2018).

On October 1, 2018, the presiding administrative law judge (“ALJ”) issued a final initial determination (“ID”) finding that a violation of section 337 occurred in the importation into the United States, the sale for importation, or the sale within the United States after importation, of certain road milling machines and components thereof that infringed the asserted claims of the ’309 and ’530 patents, but found no violation with respect to the ’641 and ’340 patents. *See* ID, Cover.

On April 17, 2019, the Commission determined to review in part the final ID. *See* 84 FR 16882-84 (Apr. 23, 2019). In particular, the Commission determined to review the final ID’s findings and analysis pertaining to the obviousness determinations with regard to claims 26, 35, and 36 of the ’309 patent and, on review, found those claims invalid as obvious under 35 U.S.C. 103. *Id.* at 16883. The Commission affirmed the final ID’s finding that asserted claims 10 and 29 of the ’309 Patent are not invalid. *Id.* at 16883. The Commission determined not to review any of the final ID’s finding relating to the ’340, ’641, and ’530 patents. *See id.*

On July 18, 2019, the Commission found a violation of section 337 as to the '309 and '530 patents and determined that the appropriate form of relief in this investigation is: (1) an LEO prohibiting the unlicensed entry of infringing road-milling machines and components thereof covered by one or more of claim 29 of the '309 patent or claims 2, 5, 16, or 23 of the '530 patent that are manufactured abroad for or on behalf of, or imported by or on behalf of, any of the Respondents or any of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns; and (2) CDOs directed against respondents Caterpillar Paving Products, Inc. and Caterpillar Inc., and their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns. *See* 84 FR 35690-91 (Jul. 24, 2019). The Commission determined that the remedial orders “should include an exception for service and repair.” *Comm’n Op.* at 14, 23 (July 18, 2019).

Both Complainant and Respondents timely appealed the Commission’s final determination with the United States Court of Appeals for the Federal Circuit. On October 21, 2019, the Court consolidated the two appeals. *See Caterpillar v. ITC* (2019-1911, -2445), Court Order at 2 (October 21, 2019).

On March 15, 2021, the Court issued a non-precedential decision affirming the Commission’s determination of a Section 337 violation with respect to the '530 and '309 patents. *Caterpillar Prodotti Stradali S.R.L. v. International Trade Commission*, 2021 WL 960759 (Fed. Cir. 2021). The Court also reversed and vacated the Commission’s finding, adopted from the final ID, that Wirtgen failed to prove the knowledge required for inducement, and remanded as to the '641 patent for further proceedings. *Id.* at *5. The Court affirmed the Commission’s finding, adopted from the final ID, that Wirtgen had not shown use in the United States of any imported PM300 Series machine in a way that would infringe the asserted claims of the '641 patent. *Id.* at *6. The Court’s mandate issued on May 6, 2021, returning jurisdiction to the Commission.

Pursuant to the Court's remand, the Commission issued a Notice and Order requesting written submissions from the parties to address the specific further proceedings to be conducted on remand. Notice of a Commission Request for Written Submissions Pursuant to a Court Remand (June 7, 2021) ("Commission Notice"). On June 17, 2021, Wirtgen and Caterpillar filed opening submissions in response to the Commission's notice. On June 22, 2021, Wirtgen and Caterpillar filed replies to the opening submissions.

Having examined the record in this investigation, including the parties' submissions filed in response to the Commission's Notice and Order, and consistent with the judgment of the Court, the Commission has determined to modify (1) the LEO issued in this investigation to cover, in addition to its existing scope, claims 11 or 17 of the '641 patent; and (2) the CDOs issued against Caterpillar, Inc. of Peoria, IL and Caterpillar Paving Products, Inc. of Minneapolis, MN to cover, in addition to their existing scope, claims 11 or 17 of the '641 patent.

The Commission has terminated this investigation.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), and in Part 210 of the Commission's Rules of Practice and Procedure (19 CFR part 210).

By order of the Commission.

Issued: November 4, 2021.

Lisa Barton,
Secretary to the Commission.